

REMARKS

Reconsideration of the present application is respectfully requested. Claims 1-38 remain pending in the present application. Applicants wish to thank the Examiner for the indication of allowability of claims 11-15, 18, 29-33, and 36 if rewritten in independent form to include the features of the base claim and any intervening claims. Applicants respectfully request reconsideration of the application in view of the following remarks.

Claims 1-38 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Examiner acknowledges that the present invention, as claimed, recites a “process [that] produces a useful, concrete, and tangible result...” The Examiner also concedes that the present invention, as claimed, is “useful and tangible.” However, the Examiner has also asserted that the presently-claimed invention is not within the technological arts. Applicants respectfully disagree. “The constitutionally stated purpose of granting patent rights to inventors for their discoveries is the promotion of progress in the ‘useful arts,’ rather than in science.... [T]he present day equivalent of the term ‘*useful arts*’ employed by the Founding Fathers is ‘*technological arts*.’ ” (emphasis added). *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980). As noted above, the terms *useful arts* and *technological arts* are interchangeable. Because the presently-claimed invention has been acknowledged as useful (i.e., within the useful arts), the presently-claimed invention is also within the technological arts.

Even if it is assumed, for the sake of argument, that the presently-claimed invention relates to an abstract idea, when an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete, and tangible result. *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ 2d 1596, (Fed. Cir. 1998). So long as a claimed invention produces a useful, concrete, and tangible result, the claimed invention satisfies 35 U.S.C. § 101. *Id.* Because the presently-claimed invention produces a useful, concrete, and tangible result, the requirements of 35 U.S.C. §101 are satisfied.

Given the above, Applicants respectfully submit that claims 1-38 recite statutory subject matter. Withdrawal of the §101 rejection of claims 1-38 is respectfully requested.

Claims 1-5, 7-9, 16, 17, 19-27, 34, 35, and 37-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,092,197 to Coueignoux ("Coueignoux"). Claims 1 and 21, as pending, recite, *inter alia*, the feature of "informing an individual...that the entity has certified its compliance with approved privacy and data security practices..." In contrast, Coueignoux teaches "transmitting a request for publication of a fact" and an agent that requests that the user reveal facts "and provide indicia relating to authorization for publication of the revealed facts." See *Coueignoux*, col. 2, lines 40-42 and 46-48. Nowhere in Coueignoux are privacy practices or privacy law and regulations discussed, much less informing an individual that an entity has certified its compliance with approved privacy and data security practices as claimed by the present invention.

Furthermore, claims 1 and 21 also include, *inter alia*, the feature of "transmitting to the entity data indicating that the individual has been informed of the entity's privacy practices." As illustrated above, Coueignoux merely asks the user to reveal facts and also asks the user to provide indicia relating to authorization for publication of the revealed facts. "In the present embodiment, authorization to publish cannot be obtained without an explicitly positive, informed decision by the user." See *Coueignoux*, col. 13, lines 51-53. Coueignoux is only concerned with obtaining permission to publish facts of a user, not informing users of privacy practices of the entity as recited in claim 1. Applicants respectfully submit that claims 1 and 21 are not rendered obvious by Coueignoux and request that the §103 rejection thereof be withdrawn.

Claims 2-5, 7-9, 16, 17, 19-20, 22-27, 34, 35, and 37-38 are either directly or indirectly dependent from claim 1 or 21 respectively and are therefore not rendered obvious for at least the same reasons as stated above. Applicants respectfully request that the §103 rejection of claims 2-5, 7-9, 16, 17, 19-20, 22-27, 34, 35, and 37-38 be withdrawn.

Claims 6, 10, and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Coueignoux in view of U.S. Patent Application Publication No. 20020010784 to Clayton et al. ("Clayton"), which bears Application No. 09/754,898. Applicants respectfully submit that Clayton is the publication of the present application. Clayton is therefore not properly-citable

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against the present application. Applicants respectfully request that the §103 rejection of claims 6, 10, and 28 be withdrawn.

In view of the above, each of the presently-pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

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